

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William Allen et al.
Serial No. : 10/752,391
Filed : January 6, 2004
Title : REMOTE CONTROLLING

Art Unit : 2612
Examiner : Vernal U. Brown
Conf. No. : 3571

Mail Stop Appeal Brief - Patents
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

(i) *Real Party in Interest*

Bose Corporation.

(ii) *Related Appeals and Interferences*

None

(iii) *Status of Claims*

Claims 1-3, 7 and 8 being appealed stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sciammarella as a primary reference in view of Ellis as a secondary reference. Claims 9-12 are allowed. Claims 13-20 are cancelled.

(iv) *Status of Amendments*

No amendment was filed subsequent to the November 10, 2009, final action.

(v) *Summary of Claimed Subject Matter*

The method comprises providing to a user of a control device, such as remote control unit 50 FIG. 2, an indication of a value representative of a current preset associated with a sound signal source, such as on display 52, the current preset having been preselected by the user as being of interest, such as 124 FIG. 4B. The method further involves simultaneously providing an indication of a value of a possible new preset associated with the sound signal source, such as

126, and providing the user an edited option allowing the user to change the current value to the new value. Page 7, lines 23-27.

(vi) *Grounds of Rejection to be Reviewed on Appeal*

1. Whether claims 1-3, 7 and 8 meet the conditions for patentability under 35 U.S.C. §103 over Sciammarella as a primary reference in view of Ellis as a secondary reference.
2. Whether Claim 6 meets the conditions for patentability under 35 U.S.C. §103(a) as being unpatentable over the primary and secondary references and further in view of Obayashi as a tertiary reference.

(vii) *Argument*

- I. AT LEAST BECAUSE THE REFERENCES CANNOT BE COMBINED TO MEET THE LIMITATIONS IN CLAIMS 1-3, 7 AND 8 PROPERLY CONSTRUCTED, THESE CLAIMS MEET THE CONDITIONS FOR PATENTABILITY UNDER §103.

The final Action states:

Claims 1-3, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sciammarella et al. US Patent 6425129 in view of Ellis et al. US Patent 7185355.

Regarding claims 1 and 8, Sciammarella et al. teaches a method comprising: providing, to a user of a remote control device having a display, a graphical item representative (element 802 in figure 8A) of an indication of a value representative of a current preset associated with the sound signal source (col. 8 lines 43-54) and providing the user with the option to change the current value to a new value (col. 8 lines 51-60). Sciammarella et al. teaches the CPU 30 accesses user settings and preferences for configuring the system for providing functionality including the channel preview functionality (col. 4 lines 26-27-35) but is not explicit in teaching pre-select the channels to be previewed. Ellis et al. in an analogous art teaches allowing a user to pre-select the channels that are of interest to the user (col. 1 lines 41-50).

It would have been obvious to one of ordinary skill in the art to modify the system of Sciammarella et al. as disclosed by Ellis et al. because allowing the current preset to be pre-selected by the user allows the user to view channels that are of interest to the user and provides a more convenient means of selecting the user's favorite channels.

Regarding claim 2, Sciammarella et al. teaches the presets is associated with a sound signal source in a multi-media system (col. 2 lines 44-50).

Regarding claim 3, Sciammarella et al. teaches multi-media system produces audio and video and therefore comprises an audio system (col. 3 lines 31-40).

Regarding claim 7, Sciammarella et al. teaches the remote control communicates with a second device (2) to effect change to the new preset value (col. 4 lines 60-63).

Pp. 2-3.

This ground of rejection is respectfully traversed.

In *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q. 2d 1385, 1396 (U.S. 2007), after stating the steps “in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent in issue”, the Court said, “To facilitate review this analysis should be made explicit.” See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obvious grounds cannot be sustained by mere conclusory statements, instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness””).

“A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S., at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to ““guard against slipping into the use of hindsight””(quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 [141 USPQ 549] (CA6 1964))). *Id.* 1397.

In *Ex parte Aylward*, (BPA&I, Appeal No. 2007-2368 December 4, 2007) the Board said in reversing a final rejection,

“Both anticipation under §102 and obviousness under §103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . The second step in the analysis requires a comparison of the properly constructed claims to the prior art”. *Medichem, S.A. v. Rolabo, SL*, 353 F. 3d 928, 933 (Fed. Cir. 2003) (internal citations omitted):

A. CLAIM CONSTRUCTION

“The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art.” *In re Lowry*

32 F. 3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F. 2d. 1381, 1385 (Fed. Cir. 1983). Slip Op. Pp. 7-8.

* * *

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *in re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781,783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F. 2d 1048, 1051 (CCPA 1976)).

In *Ex parte Hamilton* (BPA&I Appeal No. 2007-3091, March 11, 2008) in reversing a final rejection the Board said:

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991), and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Slip Op. Pp. 5-6.

The pertinence of the specification to claim construction is reinforced by the manner in which a patent is issued. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). *Phillips v. AWH Corp.*, 76 U.S.P.Q. 1321, 1329 (Fed. Cir. 2005) (en banc).

The claim language must be interpreted in light of the specification as it would be interpreted by one of ordinary skill in the art. The application is entitled REMOTE CONTROLLING. FIG. 2 of the application, reproduced on the cover page of the published application, shows remote controller 50 with display 52 that furnishes the indications to the user of the control device, remote control 50, and indication of the value representative of a current preset associated with a sound signal source, the current preset having been preselected by the user as being of interest and simultaneously providing an indication of a value of a possible new preset associated with the sound signal source and providing the user an edit option.

In explaining the display on display 52 shown in FIG. 4B, the specification explains the claimed limitations in the paragraph spanning pp. 7-8 and the first full paragraph on p. 8, "While a station is highlighted, the user may enter (and may change) a new value 126 for the preset.

Both the current preset 124 and the new value 126 are shown on display 52 at the same time. To enter a new value for the highlighted preset, the user presses the center button 58 up or down to tune up or down, or the user can press the back button 68 and the forward button 70 to seek back or forward respectively.

* * *

Having the current preset value 124 and the new preset value 126 visible on display 52 at the same time makes it easier for the user to be certain that the change that will be effected is the one he wishes and allows him to retain the current setting easily if he chooses not to change it."

Neither the primary reference nor the secondary reference discloses a remote control with a display. Nor does either reference disclose "simultaneously providing an indication of a value of a possible new preset associated with the sound signal source" while "providing to a user of a control device, an indication of a value representative of a current preset associated with a sound signal source, the current preset having been preselected by the user as being of interest," as recited in all the rejected active claims.

It is therefore impossible to combine the primary and secondary references to meet the limitations of these rejected claims.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner

urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the references to meet the limitations of the rejected claims is reason enough for withdrawing the rejection of them. If this ground of rejection was repeated, the Examiner was respectfully requested to quote verbatim the language in the references regarded as corresponding to at least the limitations in at least claim 1. The Examiner did not and cannot comply with this request.

I. **CLAIM 6 MEETS THE CONDITIONS FOR PATENTABILITY UNDER §103(a) AT LEAST BECAUSE IT IS IMPOSSIBLE TO COMBINE THE REFERENCES TO MEET THE LIMITATIONS OF CLAIM 6.**

The final Action states:

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sciammarella et al. US Patent 6425129 in view of Ellis et al. US Patent 7185355 and further in view of Obayashi et al. US Patent 5404579.

Regarding claim 6, Sciammarella et al teaches providing the user with an option to change the value of a preset (col. 8 lines 51-60) but is not explicit in teaching enabling a user to confirm the possible new preset value. Obayashi et al. in an art related invention in the same field of endeavor of remote control teaches allowing a user to confirm the data entered at the remote control in order to ensure that the correct control data was entered (col. 4 lines 22-24).

It would have been obvious to one of ordinary skill in the art to modify the system of Sciammarella et al. as disclosed by Obayashi et al. because allowing a user to confirm the data entered at the remote control ensure that the correct control data was entered for activating a desired function.

Pp. 3-4.

Claim 6 is dependent upon and includes all the limitations of claim 1. We have shown above that Claim 1 is patentable over the primary and secondary references so that it is submitted to be unnecessary to further discuss the additional limitations added by claim 6.

CONCLUSION

In view of the foregoing authorities and remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in the rejected claims, the decision of the Examiner finally

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rejected claims 1-6, 7 and 8 should be reversed. Should the Board be of the opinion that one or more of the rejected claims may be allowable if amended, the Board is respectfully requested to include a statement identifying such claim allowable in such amended form and direct entry of such an amendment.

The appeal brief fee in the total amount of \$540 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050, order no. 02103-0581001/W35.

Respectfully submitted,
FISH & RICHARDSON P.C.

20 July 2010
Date: _____

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(viii) Claims Appendix

1. A method comprising
 - providing, to a user of a control device, an indication of a value representative of a current preset associated with a sound signal source, the current preset having been pre-selected by the user as being of interest,
 - simultaneously providing an indication of a value of a possible new preset associated with the sound signal source and
 - providing the user-an edit option allowing the user to change the current value to the new value.
2. The method of claim 1 in which the preset is associated with a sound signal source in a multi-media system.
3. The method of claim 2 in which the multi-media system comprises an audio system.
6. The method of claim 1 also including enabling a user to confirm the possible new preset value.
7. The method of claim 5 in which the control device communicates with a second device to effect the confirmed new preset value.
8. The method of claim 1 in which the value comprises an identifier of a station.

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(ix) *Evidence Appendix*

None

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(x) *Related Proceedings Appendix*

None